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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Brown, et al.

Confirmation No.: 8188

Application No.: 09/954,796

Examiner: Sall, El Hadji

Filing Date: 9-10-01

Group Art Unit: 2157

Title: System and Method for Distributing Software

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 6-14-06.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Brown, et al.

Group Art Unit: 2157

Serial No.: 09/954,796

Examiner: Sall, El Hadji

Filed: September 10, 2001

Docket No. 10010052-1

For: **System and Method for Distributing Software**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

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P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed June 14, 2006 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses selected responses in the following.

I. Characterizing Use and Providing Programs Based Upon the Characterization

In the Appeal Brief, Applicant notes that Parthesarathy does not teach or suggest "characterizing the use of the user based upon the user responses" or "providing software programs that may be beneficial to the user based upon the characterization of the use", as recited in claim 1. Instead, the Parthesarathy method simply comprises loading the update if the user provides permission, and not loading the update if the user does not provide that permission. Parthesarathy's system and method do not "characterize" any use of the user.

In reply, the Examiner argues on page 24 of the Examiner's Answer that Applicant has "misread" the Parthesarathy reference and that Applicant's point as to Parthesarathy's failure to teach characterizing the use and basing the software provision on that characterization is "unsupported by objective factual evidence." In support of that contention, the Examiner argues that Parthesarathy teaches "querying the user to determine whether the user desires to load new software" and "delivering software update to the computer when a new software is detected." Applicant responds by stating that even if the above Examiner assertions were assumed to be true, those teachings of the Parthesarathy reference do not anticipate Applicant's explicit recitations. Specifically, as was stated in the Appeal Brief, merely asking the user whether it is okay to download a new version of software and then delivering the software if the user replies "yes" is not "characterizing" the use of the user "based upon the user responses" or providing software programs "based upon the characterization of the use".

In short, the Examiner's interpretation of the limitations of claim 1 is unduly broad and is inconsistent with both the plain and ordinary meaning of the term "characterizing" as well as the meaning accorded to that term by Applicant's disclosure. As to the meaning provided by Applicant's disclosure, Applicant notes that it is well established in the law that claim terms are to be interpreted *in light of the specification*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part"). It is clear from Applicant's specification that "characterizing the use" of the user means actually characterizing, i.e., evaluating, the use in light of the user's responses to queries presented to the user. In other words, queries are presented to the user that elicit responses that can be evaluated to determine what programs would best serve the user relative to the user's description of the type of use the user foresees. For example, Applicant discloses:

... the profiling software 200 presents a series of questions to the user to query the user as to how the user foresees using the peripheral device 106. ...

After the user responses have been received, they are analyzed by the profiling software 200 to characterize the type of use that the user anticipates and to determine which software programs 212 to suggest to the user for downloading, as indicated in block 422.

Applicant's specification, page 10, line 24 to page 11, line 18.

As can be appreciated from the above, the claimed "characterizing" means analyzing the response and deciding which programs would be best for the user in view of how the user foresees using the peripheral device. As an even cursory review of the Parthesarathy reference reveals, Parthesarathy contemplates no such actions. Applicant respectfully submits that

Parthesarathy's failure to teach actually "characterizing" a use and providing software "based upon" the characterization is sufficient "evidence" that the Parthesarathy reference does not anticipate claim 1. Furthermore, Applicant believes that Applicant has "specifically pointed out" how the language of claim 1 distinguishes over the Parthesarathy reference.

Finally, as to the Examiner's comments on page 25 of the Examiner's Answer that "characterizing" is a "rather long and fancy word for analyzing a system or process and measuring its characteristics," Applicant respectfully submits that the word "characterizing" is not so "long" or "fancy" as to have a meaning that would escape those having ordinary skill in the art. Furthermore, Applicant agrees that "characterizing" means "analyzing." Indeed, that is the point Applicant made above. The problem with the rejection, however, is that Parthesarathy's system performs no such analysis. Again, Parthesarathy's system only asks the user if it is okay to download, and then downloads if the user responds in the affirmative.

Applicant notes that the above comments are equally relevant to Applicant's independent claims other than claim 1.

II. Querying a User as to the Needs of the User

Applicant also noted in the Appeal Brief that Parthesarathy does not teach "querying a user as to *the needs of the user*". Instead, Parthesarathy teaches, and only teaches, asking the user whether the user would like to load an update now, or load the update later. That is, "querying" performed in the Parthesarathy system/method is performed to obtain *permission to load* a system-detected program update. Clearly, such questions do not equate to questioning the user as to his or her "needs".

In reply, the Examiner argues on page 25 of the Examiner's Answer that Parthesarathy discloses querying the user as to whether the user "desires" the software update. Applicant again asserts that if what the Examiner argues were assumed to be true, Parthesarathy still does not anticipate querying a user as to the needs of the user. Specifically, asking the user whether the user *wants* the software update does not satisfy "querying the user as to the needs of the user" in view of the plain and ordinary meaning of the phrase or the meaning accorded to the phrase as defined by Applicant's specification. For example, that the user indicates that it is acceptable to download a software update provides no indication as to the needs of the user, i.e., whether the user needs that update. In many circumstances, the user will not even know whether an update is needed. This is where Applicant's invention provides utility that is not realized by the prior art, such as the Parthesarathy reference. By querying the user as to how the user foresees using a device, whether the user does or does not need the software can be determined for the user so that the user need not figure this out for himself or herself. Therefore, the decision process as to whether to download a program is, at least partially, automated for the user, thereby simplifying use and set up of a device. As was noted in Applicant's specification:

Unfortunately, the user may not be familiar with the programs and can be unsure about which programs the user should download to his or her computing device. Therefore, the user may choose to download each program, potentially wasting hard drive space, or choose to forgo one or more of the programs, potentially passing up an opportunity to use a program from which the user could derive great benefit.

Applicant's specification, page 2, lines 9-14. That problem is solved by Applicant's claimed invention. In contrast, because Parthesarathy's invention does not collect information as to the "needs" of the user, Parthesarathy's invention does not solve the problem.

As a further point, the Examiner's reasoning on page 25 of the Examiner's Answer that "the software update of the user's computer is inherently beneficial to the user" is flawed. Anyone who has installed an update realizes that this is not always the case. For example, the new version of the software may comprise new features that the user does not need. Assume, for example, that the user uses a given program for simple word processing. If a new version of the program has a publishing feature when the user contemplates no need for such publishing, the update would not be "inherently beneficial" to the user. In other words, if the original program adequately suited the user's needs, it is possible that there would be no need to update the program.

Applicant notes that the above comments are equally relevant to Applicant's independent claims other than claim 1.

III. Downloading a Program from a Storage Medium Read by the Computing Device

In the Appeal Brief, Applicant noted that, with particular reference to dependent claims 8 and 13, Parthesarathy does not describe downloading a program from a "storage medium read by the computing device". Instead, programs in the Parthesarathy system are downloaded from the Internet.

In reply, the Examiner on page 27 of the Examiner's Answer argues that Parthesarathy discloses a magnetic disk drive and an optical disc drive. What Parthesarathy does not disclose, however, is downloading the "selected software programs" based upon the characterization of

use from a storage medium read by the computing device. In other words, that Parthesarathy discloses a computer that, as is conventional, comprises a disk drive does *not* equate to downloading a program that is selected based upon a characterization of use from that disk drive.

IV. Suggesting an Alternative Selection

In the Appeal Brief, Applicant noted that, with particular regard to dependent claim 19, Parthesarathy does not teach logic configured to “suggest an alternative selection in response to receipt of a user selection that identifies a software program the user already possesses”. Applicant further noted that no support for the rejection of claim 19 under Parthesarathy was provided by the Examiner.

In reply, the Examiner argues on page 28 of the Examiner’s Answer that “Parthesarathy was not used to reject features such as ‘suggest an alternative selection in response to receipt of a user selection that identifies a software program the user already possesses.’ ” In response, Applicant notes that claim 19 was rejected by the Examiner under 35 U.S.C. § 102(e) in view of the Parthesarathy reference. *See Final Office Action* of November 2, 2005, page 2 (“Claims 1, 4-5, 7-12, 14-20 and 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Parthesarathy et al.”). Regardless, Applicant takes the Examiner’s statement as an admission that Parthesarathy does not teach logic configured to “suggest an alternative selection in response to receipt of a user selection that identifies a software program the user already possesses” as required by claim 19.

V. Querying a User as to What the User Wants to Accomplish

In the Appeal Brief, Applicant noted that, regarding claim 25, the Parthesarathy system only queries the user for permission to load an update and, therefore, Parthesarathy fails to teach or suggest “querying a user as to what the user wants to accomplish” or “providing software programs based upon the user responses”. That is, the Parthesarathy system simply asks the user for permission to load a system-detected update, with no inquiry as to “what the user wants to accomplish.”

In reply, the Examiner on page 28 of the Examiner’s Answer restates the arguments presented in relation to claim 1 regarding the “querying the user as to the needs of the user”. Applicant refers back to the discussion of that limitation provided in the foregoing, which is equally applicable to claim 25. Specifically, asking the user whether it is okay to download an update and then downloading the update falls far short of “querying a user as to what the user wants to accomplish” and “providing software programs based upon the user responses”.

VI. Determining Tasks a User Wishes to Accomplish

In the Appeal Brief, Applicant noted that, regarding claim 33, Parthesarathy fails to teach or suggest “determining tasks a user wishes to accomplish from responses provided by the user” or “installing software programs based upon the determination”. Stated simply, Parthesarathy makes no determinations as to what a user wishes to accomplish, and therefore cannot install programs based upon that determination. The Parthesarathy system asks the user for permission to load a system-detected update, and discloses nothing about “determining tasks a user wishes to accomplish.”

In reply, the Examiner on page 30 of the Examiner's Answer restates the arguments presented in relation to claim 1 regarding the "querying the user as to the needs of the user". Applicant refers back to the discussion of that limitation provided in the foregoing, which is equally applicable to claim 33. Specifically, asking the user whether it is okay to download an update and then downloading the update falls far short of "determining tasks a user wishes to accomplish from responses provided by the user" and "installing software programs based upon the determination".

VII. Motivation to Modify the Parthesarathy System/Method

In the Appeal Brief, Applicant noted that there is no motivation to modify the Parthesarathy system/method in view of the Bradford reference. Bradford discloses a method and system for facilitating the refinement of *data queries*. Given that Parthesarathy is not conducting a data query and is instead only querying a user as to whether to load an update now or later, no "refinement" of Parthesarathy's querying would be seen as desirable to a person having ordinary skill in the art.

In reply, the Examiner on page 31 of the Examiner's Answer cites boilerplate law without providing a reasonable explanation as to why a person having ordinary skill in the art would be motivated to add Bradford's refinement of data queries to a system in which no such data queries are even posed to a user. Clearly, the only such motivation is provided by Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight

combination of components selectively culled from the prior art to fit the parameters of the invention).

VIII. Kroening's Lack of Teaching as to Suggesting an Alternative Selection

In the Appeal Brief, Applicant noted in regard to claims 6, 13, and 19 that the Examiner states that Kroening teaches “an alternative method of selecting software to download”. Applicant asserted that, even if that is true, Kroening still fails to teach “suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses”, as in claim 6 (similar recitations contained in claims 13 and 19). Significantly, Kroening says nothing of such a process in column 7, line 51 to column 8, line 21, which were identified in the Office Action.

In reply, the Examiner on page 32 of the Reply Brief argues that Kroening discloses suggesting an alternative selection and cites column 7, line 51 to column 8, line 21 of the Kroening reference without explanation. That portion of the Kroening reference provides as follows:

When the customer of the computer system 100 desires to restore some initially installed component, communication software 206 is run and a connection between customer computer system 100 and vendor computer system 202 is initiated. The customer computer system 100 then executes programming to identify to the vendor computer system 202 the software components to be downloaded from vendor computer system 202 to be restored on customer computer system 100. In one embodiment, identification data 208 contains a list of all preinstalled software components and user may select the particular components to restore via an input device such as a keyboard or pointing device.

Less savvy computer users may not be able to identify by filename particular components to replace. Thus, as yet a further additional or alternative input method, the user input may be obtained through a series of interactive prompts, such as a software "wizard" or the like to guide a user through the process of selecting files to restore wherein a series of questions are asked and wherein the answers to the questions dictate the subsequent questions. For example, such a questionnaire or wizard interface might begin by asking whether there is any malfunctioning of customer computer system 100. If so, further questions about the nature of the malfunction may be asked to determine the necessary files to transfer, which may range from a replacement of a single file such as the driver of a malfunctioning hardware device or an accidentally deleted file to a complete system restore, e.g., in the event of catastrophic hard disk drive failure. On the other hand, if the user indicates that the system is currently not malfunctioning, the user interface could then inform the user of components that have updated versions available, which may then be downloaded. As yet a further additional or alternative method of selecting components to download, one or more files, such as an error log, configuration files, etc., of computer 100 may automatically be transferred to vendor computer system 202 for evaluation to determine which software components need to be restored or replaced.

Kroening, column 7, line 50 to column 8, line 21.

Applicant sees no teaching of, for example, "suggesting an alternative selection after receiving a user selection that identifies a software program the user already possesses" (see claim 6). Specifically, the above excerpt says nothing of "suggesting an alternative selection" or that the suggestion is in response to receiving a user selection that "identifies a software program the user already possesses".

IX. Querying the User as to How the User Plans to Use a Peripheral Device

In the Appeal Brief, Applicant noted in regard to claims 3 and 21 that the Examiner admitted that Parthesarathy does not teach “querying the user as to how the user plans to use a peripheral device”. However, the Final Office Action identified the Himmel reference as providing the missing teaching, and further alleges that claims 3 and 21 would have been obvious under Parthesarathy in view of Himmel. Applicant asserted that Himmel neither teaches querying a user as to a contemplated use of a device, nor provides a teaching that is properly combinable with the Parthesarathy reference.

In reply, the Examiner notes that claims 3 and 21 do not literally recite “querying a user as to a contemplated use of a device”. This is true. However, that action is substantially equivalent to the claimed “querying the user as to how the user plans to use a peripheral device”, and Himmel clearly fails to teach that limitation. As to that limitation, the Examiner argued in the Final Office Action that Himmel “teaches querying the user as to how the user plans to use a peripheral device” and cited column 2, line 66 to column 3, line 2 of the Himmel reference for support. That portion of the reference provides as follows:

Alternatively, the method may include informing a user of the computer that the peripheral device has been identified, and querying the user whether to accept and configure the peripheral device.

Himmel, column 2, line 66 to column 3, line 2.

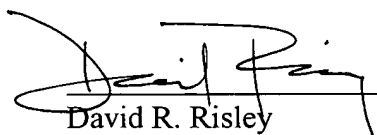
Clearly, the above excerpt does not teach, as is suggested by the Examiner, “querying the user as to *how* the user plans to use a peripheral device”. Instead, as before, the user is merely being asked for *permission* to do something, in this case whether to “accept and configure” a

device. Nothing in the cited portion of the Himmel reference even suggests querying a user as to “how” the user will use the device.

CONCLUSION

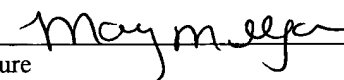
In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,


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